

REMARKS

Claims 1-27 are pending. The Examiner's reconsideration of the rejections is respectfully requested in view of the amendments and remarks.

Claims 1-27 have been rejected under 35 USC §101 for nonstatutory subject matter. The Examiner suggested essentially that the computer system must set forth a practical application or §101 judicial exception to produce a real-world result.

Claims 1 and 8 claim, *inter alia*, “merging the second session with the first runtime of the first session to create a second runtime including the first session and the second session, wherein the second runtime is queried to evaluate a first navigation path between the first test and the second test and output a weight of the first navigation path adapted to be compared against a weight of at least a second navigation path for selecting one of the first and second navigation path, the selection defining a path of execution of the analytic asset.”

The limitation which recites “output a weight of the first navigation path adapted to be compared against a weight of at least a second navigation path for selecting one of the first and second navigation path, the selection defining a path of execution of the analytic asset” is believed to satisfy the requirements of 35 USC §101. For example, In *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981), the Court noted, “when [a claimed invention] is performing a function which the patent laws were designed to protect (e.g., transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of Section 101.” *Diehr*, 450 U.S. at 192. In Claims 1 and 8, a path of execution of an analytic asset is defined. The path of execution of an analytic asset is a reduction of the runtimes; the path of execution of an analytic

asset is therefore believed to be a useful, tangible and concrete result of the application of the claimed limitations. For example, consider the following:

“[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result’ -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601.

It is important to note that a resulting use of the final share price for recording and reporting purposes, etc., is not recited in the claims of the patent at issue in *State Street*. It is enough for the result, e.g., a final share price or a path of execution of an analytic asset, to be useful. A limitation explicitly claiming a use of the result is not needed to satisfy the requirements of 35 USC 101.

The Examination Guidelines are instructive here; the Guidelines provide that “the claimed invention in *Arrhythmia* ‘constituted a practical application of an abstract idea (a mathematical algorithm, formula, or calculation), because it corresponded to a useful, concrete and tangible thing—the condition of a patient’s heart’” (*Arrhythmia Research Tech. v. Corazonix Corp.*, 958 F.2d 1053, 1059, 22 USPQ2d 1033, 1038 (Fed. Cir. 1992)) (see page 38, lines 6-10). In view of the foregoing, the claimed invention is believed to be directed to a “practical application,” namely, in selecting one of the first and second navigation path based on weights thereof.

Claims 2-7, 13, and 26 depend from Claim 1. Claims 9-12, 14-25, and 27 depend from Claim 8. The dependent claims are believed to be allowable for at least the reasons given for Claims 1 and 8. Reconsideration of the rejection is respectfully requested.

Claims 1-27 have been rejected under 35 USC §103(a) as being unpatentable over Bowman-Amuah (US 2003/0058277, hereinafter Bowman). The Examiner suggested that Bowman teaches or suggests all of the limitations of Claims 1-27.

Claims 1 and 8 claim, *inter alia*, “merging the second session with the first runtime of the first session to create a second runtime including the first session and the second session, wherein the second runtime is queried to evaluate a first navigation path between the first test and the second test and output a weight of the first navigation path adapted to be compared against a weight of at least a second navigation path for selecting one of the first and second navigation path, the selection defining a path of execution of the analytic asset.”

Bowman teaches a method for assigning a view to an activity (see Abstract). Bowman does not teach or suggest “the second runtime is queried to evaluate a first navigation path between the first test and the second test and output a weight of the first navigation path adapted to be compared against a weight of at least a second navigation path for selecting one of the first and second navigation path, the selection defining a path of execution of the analytic asset.” Bowman teaches a practitioner selecting components for a framework (see for example, paragraphs [0361] and [0804]). The selection of components of a framework is performed by a user; such a selection is not believed to be analogous to the claimed selection of an execution path based on a comparison of weights on different paths. Bowman’s selection is not based on evaluations of weights on paths, essentially as claimed. Further, the components of a framework,

which are selected by a user, are not analogous to execution paths. The components are merely means for providing services (see paragraph [0427]). The selection of components for the framework in Bowman in no way defines an execution path, essentially as claimed.

For at least the foregoing reasons, Bowman fails to teach or suggest all of the limitations of Claims 1 and 8.

Claims 2-7, 13, and 26 depend from Claim 1. Claims 9-12, 14-25, and 27 depend from Claim 8. The dependent claims are believed to be allowable for at least the reasons given for Claims 1 and 8. Reconsideration of the rejection is respectfully requested.

For the forgoing reasons, the application, including Claims 1-27, is believed to be in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

Respectfully submitted,

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